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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES D. KELLY and MICHAEL L. REGAL

Appeal 2009-006496¹
Application 10/669,119
Patent 5,996,036
Technology Center 2100

Before ALLEN R. MacDONALD, *Vice Chief Administrative Patent Judge*,
LINDA E. HORNER and JOHN A. JEFFERY, *Administrative Patent*
Judges.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL²

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 18 and 19. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

¹ Appeal No. 2009-007162 (Appl'n 11/503,541) is related to this appeal. *See* App. Br. 1-2.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

The application on appeal seeks a second reissue of U.S. Patent 5,996,036 (“the ‘036 patent”). As set out in more detail in our Findings of Fact, one reissue patent has already issued.

The present reissue application is related to Appeal No. 2009-007162 (Appl’n 11/503,541), where another expanded panel of this Board affirmed the Examiner’s rejections under 35 U.S.C. § 251. *See Ex parte Staats*, No. 2009-007162, 2010 WL 1725728 (BPAI 2010) (non-precedential), *appeal docketed*, No. 2010-1443 (Fed. Cir. Aug. 4, 2010).³ Since the present application pertains to substantially the same issue of law as in *Staats*,⁴ the reasoning in *Staats* applies largely to the issue before us in this appeal.

Appellants’ invention reorders transactions in a computer system. Specifically, an arbitration circuit is (1) coupled with slave devices having transactions queued for execution, (2) can signal any of the slave devices to reorder their transactions without signaling a microprocessor of the computer system. *See generally* the ‘036 patent, col. 10, l. 31 – col. 11, l. 33. Claim 18 is illustrative:

18. An arbitration circuit for a computer system, the arbitration circuit adapted to couple with a plurality of slave devices having transactions queued for execution, the arbitration circuit further adapted to signal any of the plurality of slave devices to reorder their transactions without signaling a microprocessor of the computer system.

³ The panel in *Staats* differs from the panel in the present appeal in that Judge Horner has replaced Senior Judge McKelvey.

⁴ *Accord* Appellants’ Request to Consolidate Appeals filed June 11, 2009 (noting that Appeals 2009-006496 and 2009-007162 “deal with substantially the same issue of law”).

THE REJECTIONS

1. The Examiner rejected claims 18 and 19 under 35 U.S.C. § 251 as being based upon a defective reissue declaration. Ans. 2.⁵
2. The Examiner rejected claims 18 and 19 under 35 U.S.C. § 251 as being improperly broadened in a reissue application filed outside the two-year statutory period. Ans. 2-6.

THE DEFECTIVE DECLARATION REJECTION UNDER § 251

Appellants did not present any arguments pertaining to the Examiner's rejection of claims 18 and 19 under 35 U.S.C. § 251 as being based upon a defective reissue declaration (Ans. 2). *See* App. Br. 3-9; *see also* Reply Br. 1-6; Supp. Reply Br. 1-4. Accordingly, we summarily sustain this rejection.⁶

⁵ Throughout this opinion, we refer to (1) the Appeal Brief filed June 23, 2008; (2) the Examiner's Answer mailed August 15, 2008; (3) the Reply Brief filed October 15, 2008; (4) the Supplemental Examiner's Answer mailed November 12, 2008 ("Supp. Ans."); and (5) the Reply Brief to the Supplemental Examiner's Answer filed January 12, 2009 ("Supp. Reply Br.").

⁶ *See, e.g.*, Manual of Patent Examining Procedure (MPEP) § 1205.02, 8th ed., Rev. 7, July 2008 ("If a ground of rejection stated by the examiner is not addressed in the appellant's brief, that ground of rejection will be summarily sustained by the Board.").

THE IMPROPER BROADENING REJECTION UNDER § 251

The Examiner finds that the present continuation reissue application impermissibly broadens the patented claims beyond two years from the original patent's issuance. Ans. 2-14. In reaching this conclusion, the Examiner does not dispute that the present application is a proper continuation application of the originally-filed reissue application (10/669,119) ("the first reissue application").⁷ Nor is it disputed that Appellants indicated an intent to broaden the patented claims within two years of the original patent's issuance. *See* Ans. 5 (acknowledging that the first broadening reissue application was filed November 30, 2001 which is two years after the original patent issued (November 30, 1999)).

Nevertheless, the Examiner concludes that the present reissue application seeks to broaden the claims in an entirely different manner that is not covered by the declaration filed in the first reissue application. Ans. 2-14; Supp. Ans. 3-6.⁸ According to the Examiner, the public would therefore not have been notified of the unrelated broadening in this application within the statutory two-year time period. *Id.*

Appellants acknowledge that claims broadened in the present continuation reissue application are unrelated to the broadening presented during the statutory two-year time period.⁹ And while Appellants

⁷ *Accord* Supp. Reply Br. 2.

⁸ Although the Examiner's page numbering in the Supplemental Answer begins with page 3 after the cover page, we nonetheless cite to the Examiner's page numbers for clarity and consistency.

⁹ *See* App. Br. 6 ("[T]he MPEP specifically addresses *the scenario here*, where the claims are broadened after the two-year period in a way that is *unrelated* to the broadening presented during that period.") (emphases added).

acknowledge that they must present an intent to broaden within the two-year period to comply with the reissue statute, Appellants nonetheless contend that the eventual scope of broadening need not be specified within this time period. App. Br. 5-6; Reply Br. 3-4. According to Appellants, so long as the public is notified of *any* intent to broaden within two years, it is unnecessary to notify the public of the specific scope of broadening within that time period. *Id.*

The issue before us, then, is as follows:

ISSUE

Have Appellants shown that the Examiner erred in rejecting claims 18 and 19 under § 251 as impermissibly broadening the patented claims via reissue outside the two-year statutory period?

This issue turns on whether a continuing reissue application can broaden patented claims beyond the two-year statutory period in a manner unrelated to the broadening aspect that was identified within the two-year period.

FINDINGS OF FACT

Original Patent

1. U.S. Patent 5,996,036 (“the original patent”) issued November 30, 1999.
2. Claims 1-17 of the original patent include three independent claims 1, 7, and 9. Claim 1 recites a method of reordering system bus transactions, claim 7 recites a computer system with multiple master and slave devices,

and claim 9 recites an arbiter comprising address and data arbitration circuits, a queuing structure, and a matching circuit. ‘036 Patent, col. 25, l. 19 – col. 28, l. 11 (text of claims 1-17).

3. Independent claim 1 of the original patent recites, in pertinent part, “at least some of the time, said arbitration circuitry, without signalling said microprocessor, signalling said particular slave device such that the system bus is granted for a later queued transaction within said particular slave device prior to being granted for an earlier queued transaction.” ‘036 Patent, col. 25, ll. 32-37.

4. Independent claim 7 of the original patent recites, in pertinent part, “arbitration circuitry coupled to the system bus and separately coupled to the multiple slave devices for, without signalling said microprocessor, signalling a particular slave device such that within said particular slave device a later queued transaction is executed prior to an earlier queued transaction.” ‘036 Patent, col. 26, ll. 7-12.

First Reissue Application

5. A first reissue application 10/006,939 was filed November 30, 2001 along with a preliminary amendment adding independent claims 18 and 19. Prelim. Amd’t Accompanying First Reissue Appl’n filed Nov. 30, 2001.

6. Claim 18 of the first reissue application recites, in pertinent part, a method of avoiding deadlock in a computer system having a split-transaction bus and a single-envelope bus bridged by a bus bridge where a retry signal is sent to a bus transaction requestor responsive to determining that executing a

bus transaction would cause deadlock. Claim 19 recites an apparatus for avoiding deadlock with commensurate functionality. Prelim. Amd't Accompanying First Reissue Appl'n filed Nov. 30, 2001, at 2.

7. A first declaration submitted in the first reissue application on November 30, 2001 (on the two-year anniversary of the patent) identifies at least one error upon which the reissue was based as follows:

This is a broadening reissue to remove limitations in the claims as issued, by which limitations the patentee claimed less than it had the right to claim in the patent.

First Reissue Appl'n, Decl. filed Nov. 30, 2001.

8. Appellants' remarks accompanying the preliminary amendment filed in the first reissue application indicate that "[s]upport for new claims 18-19 can be found in the specification of the issued patent at cols. 9-11 *et seq.* and cols. 18-19 *et seq.*" Remarks Accompanying First Reissue Appl'n, filed Nov. 30, 2001, at 2.

9. On April 30, 2002 (after the two-year anniversary of the original patent), a second declaration was filed in the first reissue application identifying at least one error upon which the reissue was based as follows:

This is a broadening reissue to remove limitations in the claims as issued, by which limitations the patentee claimed less than it had the right to claim in the patent. At least one error being relied upon as the basis for reissue is the failure to claim a method of avoiding deadlock in a computer system having a split-transaction bus and a single-envelope bus bridged by a bus bridge, the split-transaction bus and the single-envelope bus each having at least one master device and one slave device connected thereto, comprising: storing data from one or more accepted bus transactions; determining, prior to a request for a bus transaction from a requestor, if execution of such bus transaction would cause deadlock based on the stored data; and

responsive to the determination that execution of the bus transaction would cause deadlock, sending a retry signal to the bus transaction requestor.

First Reissue Appl'n, Decl. filed Apr. 30, 2002.

10. On September 18, 2002, the Examiner rejected claims 1-19 in the first reissue application due to the reissue declaration's failure to specifically identify the error to be corrected. First Reissue Appl'n, Non-Final Rej. mailed Sept. 18, 2002, at 2-3.

11. On December 26, 2002, Appellants filed a third declaration in the first reissue application identifying at least one error upon which the reissue was based as follows:

This is a broadening reissue to remove limitations in the claims as issued, by which limitations the patentee claimed less than it had the right to claim in the patent. At least one error being relied upon as the basis for reissue is the inclusion of the limitation that arbitrating between pending transactions based on arbitration policies includes an arbitration policy that responses are received by respective master devices in the same order as requests were issued by the respective master devices, as recited in claim 1.

First Reissue Appl'n, Decl. filed Dec. 26, 2002.

12. On February 21, 2003, the Examiner rejected claims 1-19 in the first reissue application since the substitute declaration filed December 26, 2002 was defective since it pertained to correcting an error in claim 1, but did not specifically identify the error to be corrected pertaining to the "totally different invention" of claims 18 and 19. First Reissue Appl'n, Non-Final Rej. mailed February 21, 2003, at 2.

13. On April 17, 2003, a fourth declaration was filed in the first reissue application identifying at least one error upon which the reissue was based as follows:

This is a broadening reissue to remove limitations in the claims as issued, by which limitations the patentee claimed less than it had the right to claim in the patent. At least one error being relied upon as the basis for reissue is the failure to claim or further claim subject matter disclosed in the specification pertaining to a method and apparatus of avoiding deadlock in a computer system having a split-transaction bus and a single-envelope bus bridged by a bus bridge.

First Reissue Appl'n, Decl. filed Apr. 17, 2003.

14. The Examiner allowed the first reissue application on June 23, 2003, and the first reissue patent issued as US RE38,428 E on February 10, 2004.

Second Reissue Application (The Application on Appeal)

15. A second reissue application 10/669,119 (the application on appeal) was filed September 22, 2003 ("the present reissue application"). The second reissue application is said to be a continuation of the first reissue application.

16. A preliminary amendment was filed accompanying the second reissue application that (1) cancelled claims 1-17, and (2) added claims 18 and 19. Claim 18 added via this amendment recites: "An arbitration circuit for a computer system, the arbitration circuit adapted to couple with a plurality of slave devices having transactions queued for execution, the arbitration circuit further adapted to signal any the [sic] slave devices to reorder their transactions without signaling a microprocessor of the

computer system.” Claim 19 added via this amendment recites: “A computer-implemented method for reordering transactions, the method comprising: receiving and queuing within a slave device a plurality of transactions for execution; signaling the slave device to reorder its transactions without signaling a microprocessor of the computer that the transactions are being reordered.” Second Reissue Appl’n, Prelim. Amd’t filed Sept. 22, 2003.

17. Appellants’ remarks accompanying the preliminary amendment filed in the second reissue application indicate that “[s]upport for new claims 18-19 can be found in the specification of the issued patent at cols. 9-11 *et seq.* and cols. 18-19 *et seq.*” Remarks Accompanying Second Reissue Appl’n, filed Sept. 22, 2003.

18. On Sept. 22, 2003, a declaration was filed in the second reissue application identifying at least one error upon which the reissue was based as follows:

This is a broadening reissue to remove limitations in the claims as issued, by which limitations the patentee claimed less than it had the right to claim in the patent. At least one error being relied upon as the basis for reissue is the failure to claim a method of avoiding deadlock in a computer system having a split-transaction bus and a single-envelope bus bridged by a bus bridge, the split-transaction bus and the single-envelope bus each having at least one master device and one slave device connected thereto, comprising: storing data from one or more accepted bus transactions; determining, prior to a request for a bus transaction from a requestor, if execution of such bus transaction would cause deadlock based on the stored data; and

responsive to the determination that execution of the bus transaction would cause deadlock, sending a retry signal to the bus transaction requestor.

Second Reissue Appl'n, Decl. filed Sept. 22, 2003.

19. On June 23, 2004, the Examiner rejected claims 18 and 19 in the second reissue application since the declaration filed September 22, 2003 was defective since it did not specifically identify the error to be corrected pertaining to the "totally different invention" of claims 18 and 19. Second Reissue Appl'n, Non-Final Rej. mailed June 23, 2004, at 2-3.

20. On December 23, 2004, Appellants filed an amendment (1) amending claims 18 and 19, and (2) adding claims 20-26. Second Reissue Appl'n, Amd't filed Dec. 23, 2004.

21. On December 23, 2004, Appellants filed a second declaration in the present reissue application identifying at least one error upon which the reissue was based as follows:

This is a broadening reissue to remove limitations in the claims as issued, by which limitations the patentee claimed less than it had the right to claim in the patent. At least one error being relied upon as the basis for reissue is the failure to claim an arbitration circuit for a computer system, the arbitration circuit adapted to couple with a plurality of slave devices having transactions queued for execution, the arbitration circuit further adapted to signal any the [sic] plurality of slave devices to reorder their transactions without signaling a microprocessor of the computer system. Another error being relied upon as the basis for reissue is the failure to claim a computer-implemented method for reordering transactions, the method comprising: receiving and queuing within a slave device a plurality of

transactions for execution; and signaling the slave device to reorder its transactions without signaling a microprocessor of the computer system that the transactions are being reordered.

Second Reissue Appl'n, Decl. filed Dec. 23, 2004.

22. On January 26, 2005, the Examiner (1) indicated that claims 18 and 19 were allowable, and (2) withdrew claims 20-26 from consideration as being directed to a non-elected invention. Second Reissue Appl'n, Final Rej. mailed Jan. 26, 2005, at 2.

23. On March 14, 2006, Appellants cancelled claims 20-26. Second Reissue Appl'n, Amd't filed Mar. 14, 2006, at 2.

24. On August 1, 2007, the Examiner rejected claims 18 and 19 under § 251 as (1) being based on a defective declaration, and (2) impermissibly broadening the originally-patented claims beyond the two-year statutory period. Second Reissue Appl'n, Non-final Rej. mailed Aug. 1, 2007, at 3.

25. The Examiner later finally rejected claims 18 and 19 on these grounds, and Appellants appealed that decision. Second Reissue Appl'n, Final Rej. mailed Nov. 20, 2007; Notice of Appeal filed Apr. 21, 2008.

ANALYSIS

This appeal, like the related appeal in *Staats*, presents us with a novel issue which hinges on one fundamental question: Can a continuing reissue application broaden patented claims beyond the statutory two-year period in a manner *unrelated* to the broadening aspect that was identified within the two-year period? Put another way, is it enough under the law to merely present an *intent* to broaden that is limited to a particular aspect (e.g., a particular embodiment of the invention) within the two-year period, yet

broaden in unforeseeable ways (e.g., pertaining to other unrelated aspects or other embodiments) outside the two-year period?

To answer these questions, we first turn to the statute. Section 251 governs reissuing defective patents “deemed wholly or partly inoperative or invalid, . . . by reason of the patentee claiming more or less than he had a right to claim in the patent” 35 U.S.C. § 251, ¶ 1. Although this statute is “remedial in nature,” and “based on fundamental principles of equity and fairness, . . . not every event or circumstance that might be labelled ‘error’ is correctable by reissue.” *In re Weiler*, 790 F.2d 1576, 1579 (Fed. Cir. 1986). Notably, the statute mandates that “[n]o reissued patent shall be granted enlarging the scope of the claims of the original patent *unless applied for within two years from the grant of the original patent.*” 35 U.S.C. § 251, ¶ 4 (emphasis added).

This two-year limit codifies a long-standing equitable doctrine of laches applied to broadening reissue applications,¹⁰ and ensures that the public is timely notified of the intention to broaden patented claims. *See In re Graff*, 111 F.3d 874, 877 (Fed. Cir. 1997). Notice is critical since the potential expansion of the patentee’s patent rights via reissue likewise affects the public’s rights in an increased likelihood of infringing that expanded scope, notwithstanding the intervening rights provisions of § 252. *See* 35 U.S.C. §§ 271 and 252. The reissue statute therefore “balances the purpose of providing the patentee with an opportunity to correct errors of inadequate claim scope, with the public interest in finality and certainty of patent rights.” *Graff*, 111 F.3d at 877 (citation omitted). As such, the

¹⁰ P.J. Federico, *Commentary on the New Patent Act*, 35 U.S.C.A. § 1 (West 1954), *reprinted in* 75 J. Pat. & Trademark Off. Soc’y 161, 205 (1993).

“public is entitled to rely on the absence of a broadening reissue application within two years of grant of the original patent.” *Id.*

In this appeal, the original patent issued with three independent claims directed to (1) a method of reordering system bus transactions; (2) a computer system with multiple master and slave devices; and (3) an arbiter comprising address and data arbitration circuits, a queuing structure, and a matching circuit. FF 2. Two years after the original patent issued, Appellants filed a first broadening reissue application. FF 5. Despite some technical defects with this filing, the broadening was nonetheless considered to be timely and limited to the deadlock-avoidance aspect embraced by the added claims in that application.¹¹

But nearly four years after the original patent’s issuance, in the present reissue application, Appellants seek to broaden the originally-patented claims in a manner germane to an aspect unrelated to the broadening intended within the two-year statutory period—a broadening not mentioned in, or consistent with actions taken in connection with, the first

¹¹ Although Appellants did not specify the nature of the broadening with particularity in identifying the error to be corrected in the originally-filed first reissue declaration, Appellants nevertheless concurrently added claims via a preliminary amendment that were limited to an aspect pertaining to avoiding deadlock in a computer system having a split transaction bus and a single-envelope bus bridged by a bus bridge where a retry signal is sent to a bus transaction requestor responsive to determining that executing a bus transaction would cause deadlock. *See* FF 6-7. Likewise, Appellants’ remarks accompanying the preliminary amendment indicate that the newly-added claims were supported by passages in the original patent’s disclosure commensurate with that aspect. *See* FF 8. Appellants later cured the noted defect by filing another declaration (the second declaration) specifying that the error to be corrected via broadening pertained to the recited aspect. *See* FF 9.

reissue application. *Compare* FF 21 *with* FF 9. Simply put, the broadening in the present reissue application is in a manner that was completely *unforeseeable* by the public within the two-year period following the original patent's issuance.¹² Despite Appellants' arguments to the contrary (App. Br. 5-8; Reply Br. 2-5), permitting such an unforeseeable broadening nearly *four years* after Appellants' original patent issued¹³ simply runs counter to the underlying public notice function of § 251—notice that must be timely to ensure meaningful reliance on the finality and certainty of patent rights. *See Graff*, 111 F.3d at 877.

Unreasonable delays in broadening patented claims undercut this fundamental public reliance. As the Supreme Court indicates, “[e]very independent inventor, every mechanic, every citizen, is affected by such delay, and by the issue of a new patent with a broader and more comprehensive claim.” *Miller v. Brass Co.*, 104 U.S. 350, 355 (1881). And “[t]he granting of a reissue for such a purpose, after an unreasonable delay, is clearly an abuse of the power to grant reissues, and may justly be declared illegal and void.” *Id.* Thus, for broadening reissues, “the rule of laches should be strictly applied; and no one should be relieved who has slept upon his rights, and has thus led the public to rely on the implied disclaimer involved in the terms of the original patent.” *Id.* at 356.

¹² *Cf. Staats*, 2010 WL 1725728, at *8 n.11 (citing oral hearing transcript noting the admitted unforeseeability of the nature of the broadening in that case).

¹³ *See* FF 15-16 (indicating that September 22, 2003 was when Appellants first indicated their intention to broaden claims directed to the particular aspect in claims 18 and 19 of the present reissue application).

Here, Appellants chose not to broaden the patented claims in a manner directed to the second embodiment within the two-year statutory period, but instead waited nearly *four years* after Appellants' original patent issued to indicate their intention to broaden in this manner. *See* FF 15-16. Indeed, Appellants acknowledge that claims broadened in the present continuation reissue application are unrelated to the broadening presented during the statutory two-year time period.¹⁴ Since we find this broadening completely unforeseeable by the public within the two-year statutory period, it runs counter to the public notice function underpinning § 251 and is therefore improper.¹⁵

To hold otherwise would effectively give Appellants a license to unforeseeably shift from one invention to another via reissue well beyond the two-year statutory period. This tactic undermines the public notice function of § 251 and exacerbates uncertainty regarding the scope of patent protection on which the public can reasonably rely—particularly for patents with large numbers of disclosed embodiments.¹⁶

¹⁴ *See* App. Br. 6 (“[T]he MPEP specifically addresses *the scenario here*, where the claims are broadened after the two-year period in a way that is *unrelated* to the broadening presented during that period.”) (emphases added).

¹⁵ *Cf. Staats*, 2010 WL 1725728, at *8 n.11 (citing oral hearing transcript noting the admitted unforeseeability of the nature of the broadening in that case).

¹⁶ *See id.* at *9 n.14 (citing oral hearing questioning whether the public could have foreseen filing a broadening continuing reissue application for a 90th embodiment beyond the two-year statutory period for a hypothetical application containing 100 embodiments, where the applicant intended to broaden claims to just a first embodiment within the two-year period).

The key cases pertaining to broadening reissues do not change our conclusion. In *In re Doll*, 419 F.2d 925 (CCPA 1970), a reissue application was timely filed less than two years after the original patent issued adding broader claims (claims 20-31). *Id.* at 926. Over two years later, however, four additional broader claims were added (claims 32-35 copied from another patent). *Id.* Two years later, claims 32-35 were amended, and two additional broader claims (claims 42 and 43) were added. *Id.* Notably, claims 32-35, 42, and 43 were not only broader than the claims originally submitted in the reissue application (including claims 20-31 added in that application), they were also presented well after the two-year statutory period. *Id.*

This broadening was permissible under § 251 since the public was notified of the patentee's intention to broaden the claims within the two-year period via the reissue application, and the statute did not preclude further broadening beyond the two-year period during the course of prosecution. *Id.* *Accord Graff*, 111 F.3d at 877. In reaching this conclusion, the *Doll* court emphasized that § 251 permits broadening patented claims if “*applied for*” (i.e., an application is filed) within two years from the original patent's grant. *Doll*, 419 F.2d at 928. The court also noted that the intervening rights provisions of § 252 provide adequate safeguards to the public in this circumstance. *Id.*

But a key fact in *Doll* distinguishes it from the present appeal. The reissue oath in *Doll* referred specifically to correcting errors via broadening *pertaining to a particular embodiment*, namely the embodiment of Figure 4

of the original patent. *Id.* at 927-28.¹⁷ Claims 20-31 were therefore added via reissue for that purpose. *See id.* Notably, it was undisputed that later-added claims 32-35, 42, and 43 were broader than claims 20-31 and, like claims 20-31, pertained to the embodiment of Figure 4. *Id.*

Although the *Doll* court held that this broadening beyond the two-year statutory period was permissible, the broadening nevertheless pertained to the specific embodiment identified in the original reissue oath.¹⁸ To the extent that this distinction was addressed in *Doll* in connection with determining whether the reissue oath was adequate as Appellants contend (Reply Br. 2),¹⁹ it is of no consequence here, for the fact remains that the broader claims filed beyond the two-year statutory period in *Doll* were commensurate with the embodiment identified in the original reissue oath. *See Doll*, 419 F.2d at 927-28. As such, in *Doll*, the public was seasonably notified of the *manner* in which the claims would be broadened (i.e., with respect to the embodiment of Figure 4), although this broadening occurred beyond the two-year statutory period.²⁰

¹⁷ *Accord In re Wittry*, 489 F.2d 1299, 1302 (CCPA 1974) (noting that “the reissue oath [in *Doll*] stated that none of the patent claims afforded protection to a *specified embodiment* of the invention covered by the new reissue claims.”) (emphasis added).

¹⁸ *Cf. Staats*, 2010 WL 1725728, at *10 n.16 (acknowledging a similar distinction at the oral hearing in the related *Staats* appeal).

¹⁹ *See also id.*, at *10 n.16 (addressing similar issue).

²⁰ *See also Buell v. Beckstrom*, 22 USPQ2d 1128, 1131-32 (BPAI 1992) (non-precedential) (holding that § 251 did not preclude presenting claims via a timely-filed divisional reissue application after the two-year statutory period that were broader than the patented claims).

This timely notice, however, does not exist in the present appeal. Unlike *Doll*, Appellants seek to broaden the patented claims in the present reissue application in manner unrelated to that specified in the originally-filed reissue declaration—a broadening totally unforeseeable to the public when that declaration was filed nearly two years earlier. *Compare* FF 16 with FF 5-6. As noted previously, since this practice runs counter to the public notice function of § 251, it is improper under that statute.

To be sure, the agency rule governing reissue declarations does not require specifying all errors to be corrected via reissue. Rather, reissue declarations need only specify “*at least one error* being relied upon as the basis for reissue.” 37 C.F.R. § 1.175(a)(1) (emphasis added). A similar provision exists for continuing reissue applications.²¹ Despite their breadth, however, these provisions must be interpreted in light of the critical public notice function for broadening reissue applications underpinning § 251. As such, the rules cannot circumvent this statutory mandate, but should be read consistent with the statutory mandate.

Moreover, the Manual of Patent Examining Procedure notes, quite broadly, that “[w]here *any* intent to broaden is *unequivocally* indicated in the reissue application within the two years from the patent grant, a broadened claim can subsequently be presented in the reissue after the two year period.” MPEP § 1412.03(IV), 8th ed., Rev. 7, July 2008 (emphases added). The MPEP further explains that “a broadened claim may be presented in a reissue application after the two years, even though the broadened claim

²¹ See 37 C.F.R. § 1.175(e) (noting that continuing reissue applications require identifying “*at least one error* in the original patent which has not been corrected by the parent reissue application or an earlier reissue application”) (emphasis added).

presented after the two years is *different* than the broadened claim presented within the two years.” *Id.* (emphasis added).

Appellants seize upon this ambiguous expansive language in the MPEP to support the contention that the MPEP permits broadening claims in any manner after two years so long as “*any* intent to broaden” was presented within two years which, according to Appellants, they have done. App. Br. 5-6; Reply Br. 3-4. Although Appellants cite to an earlier version of the MPEP in the Briefs,²² Appellants are nonetheless correct that the MPEP seemingly indicates as much given this broad language. Notably, however, the latest revision of the MPEP qualified this broad language by mandating that “any intent to broaden” must be “*unequivocally* indicated”—a requirement not satisfied by merely stating that the patent is inoperative by claiming “*more or less*” that applicant had a right to claim. MPEP § 1412.03.

²² We reach this conclusion in view of Appellants’ cited quotations from passages from MPEP § 1412.03 that omit certain passages that were inserted in the July 2008 revision. For example, Appellants quote the MPEP as stating, in pertinent part, “[w]here any intent to broaden is indicated in the reissue application within the two years from the patent grant, a broadened claim can subsequently be presented in the reissue after the two year period.” App. Br. 6. The quotation, however, omits the term “unequivocally” that was inserted between the terms “is” and “indicated” in that passage in the July 2008 revision. *See* MPEP § 1412.03. Appellants’ quotations also omit the following sentence added to the latest revision: “(Note: A statement that ‘the patent is wholly or partly inoperative by reason of claiming more or less that applicant had a right to claim’ is NOT an unequivocal statement of an intent to broaden.” *See id.* These revisions were noted at the oral hearing in connection with the related *Staats* appeal. *Staats*, 2010 WL 1725728, at *11 n.20.

Considering the MPEP passage as a whole, the added qualification could merely pertain to ensuring that the declaration was “unequivocal” with respect to articulating the intent to broaden generally (as opposed to narrowing), and not pertain to the specific manner of the broadening. But even assuming, without deciding, that this is the case, we still are unconvinced that the law permits broadening in a *completely unforeseeable manner* after two years as Appellants have done here, particularly when considering the MPEP together with the reissue statute and its crucial public notice function.

Section 251 provides that “[t]he Director may issue several reissued patents for *distinct and separate parts* of the thing patented” 35 U.S.C. § 251, ¶ 2 (emphases added). This provision has been interpreted as enabling—not limiting—to ensure that applicants are not placed under any greater burden regarding divisional or continuation reissue applications as compared to divisions and continuations of original applications, so long as the statutory requirements specific to reissue applications are met. *Graff*, 111 F.3d at 876-77.

That is, the requirements for continuation and divisional reissue applications are commensurate with those for continuation and divisional applications for original applications, with the added requirement that the statutory reissue requirements must also be met. *See id.* A divisional application is filed to cover a particular invention that is independent or distinct from other inventions that are claimed in one application. *See* 35 U.S.C. § 121. “A continuation application is a second application for the *same invention claimed in a prior nonprovisional application* and filed before the prior application becomes abandoned or patented.” MPEP

§ 201.07 (emphasis added). Both applications, however, can claim the benefit of the filing date of their respective original applications. *See* 35 U.S.C. §§ 120 and 121.

This distinction between divisional and continuation applications applies as well to reissue applications. *See Graff*, 111 F.3d at 876-77. As noted above, § 251 enables the issuance of “several reissued patents for *distinct and separate parts* of the thing patented” 35 U.S.C. § 251, ¶ 2 (emphases added). But continuation reissue applications are not ordinarily filed “for distinct and separate parts of the thing patented” as called for in this section. MPEP § 1451(II). Rather, the “distinct and separate parts of the thing patented” are more commensurate with independent and distinct inventions that would be appropriate for divisional reissue applications. *See* MPEP § 1451(I).

Inventions are distinct if (1) the inventions as claimed are not connected in at least one of design, operation, or effect, and (2) at least one invention is patentable (novel and nonobvious) over the other. MPEP § 803(II). But when claims define the same essential characteristics of a single disclosed embodiment of an invention, the “claims are not directed to distinct inventions; rather they are different definitions of the same disclosed subject matter, varying in breadth or scope of definition.” MPEP § 806.03.

While § 251, ¶ 2 permits reissue applications for “distinct and separate parts of the thing patented” (i.e., independent and distinct inventions), the other statutory requirements for reissue applications must still nevertheless be met. *See Graff*, 111 F.3d at 876-77. And these other requirements include “applying for” such an independent and distinct invention via a

reissue application (e.g., a divisional reissue application) within two years of the original patent's grant. *See* 35 U.S.C. § 251, ¶ 4; *see also Doll*, 419 F.2d at 928.

In the present reissue application, claims 18 and 19 call for, in pertinent part, (1) an arbitration circuit of a computer system that is adapted to signal slave devices to reorder their transactions without signalling a microprocessor, and (2) a method for reordering transactions by signalling a slave device to reorder its transactions without signalling a microprocessor. FF 16. Although these claims are related to aspects of arbitration circuitry recited in the originally-patented claims (*see* FF 3-4), Appellants have waited nearly *four years* after Appellants' original patent issued to indicate their intention to broaden in this manner (*see* FF 16-18)—an unreasonable delay.²³

The U.S. Supreme Court all but said as much in *Webster Elec. Co. v. Splitdorf Elec. Co.*, 264 U.S. 463 (1924). There, a divisional application was filed approximately five years after the parent application was filed in February 1910, but before the parent application issued in 1916. *Id.* at 464. In June of 1918, however, an amendment was filed in the divisional application adding broader claims that were later patented. *Id.* at 464-65.

²³ We note in passing that the mere failure to file a divisional application on disclosed, but unclaimed patentably distinct inventions during prosecution is not an error correctable by reissue. *See Weiler*, 790 F.2d at 1581-83; *see also In re Mead*, 581 F.2d 251 (CCPA 1978). Similarly, deliberately failing to file continuing applications to cover disclosed but unclaimed subject matter in the original application is likewise uncorrectable via reissue. *See In re Serenkin*, 479 F.3d 1359, 1362-63 (Fed. Cir. 2007).

Notably, the broadened claims added via this amendment were first presented to the Patent Office *eight years and four months* after the original application was filed. *Id.* at 465.

The Court held this delay was unreasonable, noting that the patentee “Kane did not originally intend to assert these amended claims, because he considered their subject-matter one merely of design and not of invention, and the inference is fully warranted that the intention to do so was not entertained prior to 1918.” *Id.* The Court noted that during all of this time, the subject matter of the broadened claims “was disclosed and in general use, and Kane and his assignee . . . simply stood by and awaited developments.” *Id.* This was not, however, “the simple case of a division of a single application for several independent inventions, . . . but [rather] a case of *unreasonable delay and neglect* on the part of the applicant and his assignee in bringing forward claims *broader* than those originally sought.” *Id.* at 465-66 (emphases added).

In reaching its decision, the Court relied heavily on equitable principles, particularly as they applied to delays in correcting errors via reissue applications,²⁴ and adopted a similar two-year time limit for divisional applications. *Id.* at 471. Although the Court later held that *Webster’s* presumptive two-year time limit was dictum, the Court nevertheless “ratified prosecution laches as a defense to infringement actions involving new claims issuing from divisional and continuation applications that prejudice intervening adverse public rights.” *Symbol Techs., Inc. v. Lemelson Med., Educ. & Res. Found.*, 277 F.3d 1361, 1364 (Fed. Cir. 2002)

²⁴ See *Webster*, 264 U.S. at 466-69 (discussing cases adopting an equitable two-year time limit to correct errors via broadening reissue applications).

(citing *Crown Cork & Seal Co. v. Ferdinand Gutmann Co.*, 304 U.S. 159 (1938) and *Gen. Talking Pictures Corp. v. W. Elec. Co., Inc.*, 304 U.S. 175 (1938)). That is, the Court ratified the doctrine of prosecution laches in *Crown Cork* and *General Talking Pictures*, but did not apply it in those cases in the absence of intervening rights.

But broadening patented claims via reissue by its very nature prejudices intervening adverse public rights since the public is entitled to rely on the patentee's rights that existed before the patent's error was corrected (i.e., before the broadening). *See* 35 U.S.C. § 252. Therefore, the doctrine of prosecution laches is particularly applicable in reissue. Indeed, these very equitable principles were codified in 35 U.S.C. §§ 251 (reissue statute) and 252 (intervening rights regarding reissued patents).²⁵

Webster is therefore analogous to the present reissue application. Like the divisional application in *Webster*, the present reissue application was filed such that it was copending with its parent reissue application (*see* FF 14-15). That is, both the divisional application in *Webster* and the present reissue application were timely filed in terms of their copendency with their respective parent applications to obtain the benefit of the earlier-filed applications. *See* 35 U.S.C. §§ 120 and 121.

But mere continuity to the parent application under §§ 120 and 121 is not enough to foreclose the doctrine of prosecution history laches in a manner commensurate with the delay in *Webster*. *See In re Bogese*, 303 F.3d 1362, 1367 (Fed. Cir. 2002) (citing *Webster* as an example of prosecution history laches). Where, as here, Appellants waited nearly *eight years* after their original patent issued to indicate their intention to broaden

²⁵ *See* n.9, *supra*, of this opinion.

claims to the independent and distinct invention pertaining to the second embodiment (*see* FF 15-16), we see no reason why this situation should be treated any differently than *Webster*. In this circumstance, the public can reasonably infer that Appellants had no such intention and therefore dedicated this subject matter to the public.²⁶

To hold otherwise would eviscerate the public notice function of § 251 by essentially giving patentees a license to unforeseeably shift from one invention to another via reissue well beyond the two-year statutory period. This tactic not only exploits latent subject matter that is reasonably presumed to be dedicated to the public by Appellants' own actions, but also circumvents the countervailing public reliance interest in the certainty and finality in patent rights guaranteed by the two-year statutory period. *See Graff*, 111 F.3d at 877.

For the foregoing reasons, Appellants have not persuaded us of error in the Examiner's rejection of claims 18 and 19 under 35 U.S.C. § 251. Therefore, we will sustain the Examiner's rejection of those claims.

CONCLUSION

Appellants have not shown that the Examiner erred in rejecting claims 18 and 19 under § 251.

²⁶ *See Sontag Chain Stores Co., Ltd. v. Nat'l Nut Co. of Cal.*, 310 U.S. 281, 291 (1940) (“[D]ue diligence must be exercised in discovering the mistake in the original patent, and that, if . . . sought for the purpose of enlarging the claim, the lapse of two years will ordinarily, though not always, be treated as evidence of an abandonment of the new matter to the public”) (quotation marks and citation omitted).

DECISION

The Examiner's decision rejecting claims 18 and 19 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

pgc

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